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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,433	11/07/2003	Ken Kawamata	12577/23	9400
23838	7590	02/08/2005	EXAMINER	
KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005				AMARI, ALESSANDRO V
ART UNIT		PAPER NUMBER		
2872				

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/702,433	KAWAMATA ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Alessandro V. Amari	2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 November 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 3-9 is/are rejected.
- 7) Claim(s) 2 and 10-16 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 07 November 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                                |                                                                             |
|------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                           | Paper No(s)/Mail Date. _____.                                               |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/7/2003</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                                                | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 7 and 14 are objected to because of the following informalities:

Regarding claim 7, line 4, the phrase, "90 days" appears to be incorrect.

Regarding claim 14, line 4, the phrase, "90 days" appears to be incorrect.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 4, 5, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Erdogan et al US 6,809,859.

In regard to claim 1, Erdogan et al teaches (see for example, Figures 2, 6) a fluorescence observing apparatus having an excitation filter unit (204) for transmitting only exciting light with particular wave-lengths, of illuminating light; and an absorption filter unit (210) for transmitting only fluorescent light produced from a specimen by irradiating the specimen with the exciting light to block the exciting light, wherein space between a half-value wavelength on a long-wavelength side of the excitation filter unit

and a half-value wavelength on a short-wavelength side of the absorption filter unit is in a range of 6-12 nm as shown in Figure 6.

Regarding claim 3, Erdogan et al teaches that the excitation filter unit and/or the absorption filter unit includes a multilayer film comprised of at least 90 layers as described in column 11, lines 13-22.

Regarding claim 4, Erdogan et al teaches that each of the excitation filter unit and the absorption filter unit includes a multilayer film comprised of SiO<sub>2</sub> and Ta<sub>2</sub>O<sub>5</sub> as described in column 8, lines 10-21 and as shown in Table 1.

Regarding claim 5, Erdogan et al teaches that the apparatus is incorporated in an optical system of a microscope as shown in Figure 2.

Regarding claims 7 and 8, Erdogan et al teaches that the apparatus is incorporated in an optical system of a microscope as shown in Figure 2, wherein each of the excitation filter unit and the absorption filter unit includes a multilayer film comprised of SiO<sub>2</sub> and Ta<sub>2</sub>O<sub>5</sub>, and the excitation filter unit and/or the absorption filter unit includes a multilayer film comprised of at least 90 layers as described in column 8, lines 10-21, column 11, lines 13-22 and as shown in Table 1.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erdogan et al US 6,809,859 in view of Salb US 5,408,996.

Regarding claims 6 and 9, Erdogan et al teaches the invention as set forth above and regarding claim 9 teaches that each of the excitation filter unit and the absorption filter unit includes a multilayer film comprised of SiO<sub>2</sub> and Ta<sub>2</sub>O<sub>5</sub>, and the excitation filter unit and/or the absorption filter unit includes a multilayer film comprised of at least 90 layers as described in column 8, lines 10-21, column 11, lines 13-22 and as shown in Table 1 but does not teach regarding claims 6 and 9 that the apparatus is incorporated in the optical system of an endoscope.

Regarding claims 6 and 9, Salb teaches a fluorescence observing apparatus incorporated in an optical system of an endoscope as shown in Figure 1.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the fluorescence observing apparatus of Erdogan et al incorporated in an optical system of an endoscope as taught by Salb in order to provide for *in vivo* visual access to tissue under examination.

#### ***Allowable Subject Matter***

6. Claims 2 and 10-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claim 2 is allowable over the prior art for at least the reason that the prior art fails to teach or reasonably suggest, "variations in half-value wavelengths of the excitation filter unit and the absorption filter unit where humidity is changed from 10% to 95% are

within 0.5 nm" as set forth in the claimed combination. Claims 10-16 are also allowable based upon their dependence on claim 2.

The prior art of record, Erdogan et al and Salb teach a fluorescence observing apparatus having an excitation filter unit and an absorption filter unit, wherein space between a half-value wavelength on a long-wavelength side of the excitation filter unit and a half-value wavelength on a short-wavelength side of the absorption filter unit is in a range of 6-12 nm. However, the prior art does not teach that variations in half-value wavelengths of the excitation filter unit and the absorption filter unit where humidity is changed from 10% to 95% are within 0.5 nm and there is no motivation or teaching to modify this difference as derived.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kawasaki US 5,710,663 teaches a fluorescence observing apparatus.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alessandro V. Amari whose telephone number is (571) 272-2306. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ava AM  
01 February 2005

  
MARK A. ROBINSON  
PRIMARY EXAMINER